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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,410	06/21/2002	Peter Eriksson	59760 (47137)	2145

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EXAMINER	
MCGILLEM, LAURA L	
ART UNIT	**PAPER NUMBER**
1636	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/031,410	ERIKSSON ET AL.	
	Examiner	Art Unit	
	Laura McGillem	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,9,10,12-15,17,19,21,23-30 and 34* is/are rejected.

7)☒ Claim(s) *2,4-8,11,16,18,20,22 and 31-33* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 June 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Arguments

Claims 1-34 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

It has been noted that claims 30 and 34 have been amended in response to the rejection under 35 USC 112, second paragraph for failing to point out and distinctly claim how neurodegenerative diseases such as Parkinson's and Alzheimer's disease can be treated by electrofusion of two cell-like partners. Applicants have amended claims 30 and 34 to recite, "whereby one or more of drugs, gene, proteins, DNA or RNA is administered to a subject".

Claims 30 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is being maintained for reasons of record in the previous Office Action, mailed 5/03/2005 and for reasons outlined below.

In the previous Office Action, claims 30 and 34 were rejected under 35 USC 112, second paragraph because it was unclear how neurodegenerative disease could be treated by electrofusion of two cell-like partners. Applicants' amendment of the claims does not remedy this, but instead merely recites administering drugs, genes, proteins, DNA or RNA to a subject. It is still unclear what relevance electrofusion of two cell-like partners has to the treatment of said neurodegenerative diseases.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 9, 10, 13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chiu et al et al (Science, 1999, volume 283, pages 1892-1895). This rejection is maintained for reasons of record in the Office action mailed 5/3/2005 and for reasons which are outlined below.

Applicants traverse this rejection by asserting that the Chiu et al reference is not properly cited as a 102(b) reference because it was not published more than one year prior to the priority date of the instant application. Applicants assert that they are entitled to the priority date of the Swedish application (9902817-7), filed 7/30/1999. Furthermore, Applicants have amended the specification to explicitly include reference to the Swedish priority document.

Applicants' arguments filed 9/01/2005 have been fully considered, but they are not persuasive. Applicants are directed to review the 35 USC § 102(b) statute (stated above) which states that a person is entitled to a patent unless the instant invention was patented or described in a printed publication in this or a foreign country... more than one year prior to the date of application for patent **in the United States**. The International Application (PCT/SE00/01484) designates the United States in the application, and therefore qualifies it as an application in the US, while the Swedish application (9902817-7) does not qualify as an application in the United States. The

Chiu et al reference was published 3/19/1999, clearly more than one year prior to the US filing date (i.e. the International filing date 7/13/2000), and prior to the foreign (119(a)-(d)) filing date of 7/30/1999.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 9, 10, 13-15, 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu et al et al (Science, 1999, vol. 283, pages 1892-1895), in view of Prather et al (US 4,994, 384).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu et al et al, in view of Tanaka et al (US 4,894,343).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chui et al in view of Chang et al (US 4,970,154).

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu et al et al in view of Kranz et al (Sex Plant Reproduction, 1991, vol. 4, pages 12-16).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu et al et al in view of Steenbakkers (US 6,020,170).

Claims 19 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu et al et al in view of Walker et al (US 6,041,252).

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu et al et al. in view of Walters et al (US 6,010,613).

Claims 30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu et al et al in view of Heller et al (US 5,827,736).

The rejection is expanded to include the limitations of newly amended claims 30 and 34 as a result of Applicant's amendment filed 9/1/2005. The limitations recited in claims 30 and 34 are disclosed in the Heller et al reference cited in the previous Office Action. Heller et al teach therapeutic Sertoli-secretory cell fusions where the secretory cells are chromaffin cells, and are useful for treatment of Parkinson's disease, and that the treatment can include genetically engineered secretory products by introduction of exogenous genetic material into a desired host cell (see column 1, lines 14-17 and column 4, lines 24-28, in particular), which reads on treatment of a neurodegenerative disease such as Parkinson's disease whereby genes, DNA, RNA or proteins are administered to a subject.

These rejections are maintained for reasons of record in the Office action mailed 5/3/2005 and for reasons which are outlined below.

Applicants traverse the rejections on the grounds that the Chiu et al reference was not properly cited as a 35 USC § 103(a) reference because it was not published more than one year prior to the priority date of the instant application. Applicants state that since Prather et al, Tanaka et al, Walters et al, Chang et al, Kranz et al, Steenbakkers, Heller et al and Walker et al do not teach or suggest each and every element of each claim, they do not render the instant claims obvious.

Applicants' arguments filed 9/01/2005 have been fully considered, but they are not persuasive.

As stated above, Chiu et al reference is properly cited as a reference because Chiu et al et al was published 3/19/1999, clearly more than one year prior to the US filing date (i.e. the International filing date 07/13/2000) and prior to the foreign (119(a)-(d)) filing date of 7/30/1999.

Conclusion

Claims 2, 4-8, 11, 16, 18, 20, 22, 31-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura McGillem whose telephone number is (571) 272-8783. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laura McGillem, PhD
10/5/2005

DAVID GUZO
PRIMARY EXAMINER